

REMARKS

Claims 1, 3-9, 11 and 13-18 have been amended. In particular, Claim 18 has been written in independent form including all of the limitations of a base claim and any intervening claims. Claim 9 has been amended to depend from Claim 1. Claims 12 and 19-20 have been canceled. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and following remarks:

Claim Objections:

- 1) Claims 4, 6 and 18-20 were objected to under 37 C.F.R. 1.75 (c) as being of improper dependent form.

1.1 Claims 4, 6 have been amended to recite “~~using the method of claim 1 to~~ producing a group of individual package” as suggested by the Examiner.

1.2 Claim 18 has been amended to an independent claim by fully comprising the steps of the parent claim as suggested by the Examiner.

1.3 Claims 19-20 have been canceled.

- 2) Claims 8, 9 and 12 are objected because of the informalities “selecting a period of time such as a”.

2.1 in Claim 8(a), the term “such as” has been removed to claim 21 which appears as a new dependent claim.

2.2 in Claim 9(a), “such as” has been removed.

2.3 Claim 12 has been canceled.

- 3) Claim 8 is objected because of the missing a word/phrase “ which becomes the size”

3.1 in Claim 8(b), it has been amended as suggested by the Examiner.

- 4) Claim 12 is objected because of the missing a word/phrase “ it is statistically likely”

4.1 Claim 12 has been canceled.

Rejections under the first paragraph of 35 U.S.C. § 112

Claims 1, 9, and 12 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement and best mode requirements. The Examiner asserts that “the disclosure fails to state or teach one of ordinary skill in the art the best mode for selecting a size of a group of packages.”

Claim 1 has been amended, Claim 9 has been amended to depend from Claim 1 and Claim 12 has been canceled. Any of the methods discussed by the Examiner can be appropriate for selecting the size of the group of packages, depending on the complexity of the calculation to be made. Those having ordinary skill in the art can readily appreciate that the particular method for selecting the size can be determined using any method for calculation. As such, the particular best mode was contemplated by the inventor. Since the inventor did not know that “one mode was better than the other”. No best mode violation can occur (M.P.E.P. §2165.03). Moreover, even to the extent that any particular method would be considered better than another, one skilled in the art would be enabled to mark and use that mode based on ordinary skill in the art. Thus, for this additional reason, no best mode violation has occurred. As such, ordinary skill is all that is needed to meet the enablement requirement. Accordingly, withdrawal of both rejections under U.S.C. § 112 1st paragraph is respectfully requested.

Rejections under the second paragraph of 35 U.S.C. § 112

a) Claims 1, 3-9, and 11, 12 and 15-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to point out and distinctly claim the subject matter...”

The Examiner asserts that “Regarding Claims 1, 9 and 12 the disclosure does not clearly define the phrase “statistically likely to a degree acceptable to the user”..... as claimed vague and indefinite.”

Claim 1 (d) has been amended to “whereby, it appears to the consumer that most of the images appearing on each package in the group of packages are different”. Claim 12 has been canceled.

b) The Examiner asserts that “Regarding Claims 3, 11, 16 and 17 the disclosure does not clearly define the phrase “periodically”. In Claim 3, 11, 16 and 17, this term has been amended to “after a selected time period”.

c) The Examiner asserts that “Regarding Claims 4-7 and 17 the disclosure does not clearly define the phrase “likely”. In Claim 4-7, the term has been amended to “appear to the consumer to bear different image at each consumer’s purchase.”

d) The Examiner asserts that “Regarding Claims 5, 7 and 17 the disclosure does not clearly define the phrase “form a random image”. In Claim 4-7, this term has been amended to “appear to the consumer to bear different image at each consumer’s purchase.”

e) The Examiner asserts that “Regarding Claims 9 (f) and 12(h) the disclosure does not clearly define the phrase “sufficient”. Claim 12 has been canceled, and step (f) of Claim 9 no longer is included.

Rejections under 35 U.S.C. § 101

Claims 1-17 have been rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner asserts: “Claims 1-17 only recite an abstract idea. For a claimed invention to be statutory, it must produce a useful, concrete, and tangible result.”

As amended, Claim 1 clearly recites a tangible result. The preamble requires “a method for preparing customized customer product packaging by varying images appearing on packages of product” In the last step of the claim, a group of packages is definitively recited. Accordingly, the claim recites a tangible result that is more than merely as abstract idea. As such, the claims are directed to patentable subject matter, and withdrawal of the rejection under 35 U.S.C. § 101 is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

- a) Claims 1-8 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 3,770,278).

The claims have been amended to recite that the images in the group of packages are “randomly selected”. The Mueller reference neither teaches nor suggests this element of Applicant’s claims. Mueller discloses a cookie game in which each strip of paper contains a segment of a written composition which is interrelated with segments on other fortune cookie papers associated with other cookies in the package. When all the papers in the package are arranged side-by-side in a predetermined sequence they recreate the written composition. As further elaborated in Column 2, lines 15-17, the fortune cookies of a given game of Mueller “comprise a set and require packaging by sets rather than **random selection**.” Indeed, the fortune cookie game must have a complete set of fortunes for the game to be complete. The game cannot be completed using **random selection** because such selection would not result in a complete set in each game.

In contrast to Mueller, the present application is directed to varying images appearing on packages of products which involve the user defining several parameters. For instance, the user selects or determines the number of packages. Furthermore, the embodiments are scalable, according to Paragraph [0052]. Accordingly, the present embodiments are more variable than the fortunes in the cookie game Mueller. Neither the random selection, nor the variants and scalability of the present embodiments is taught or suggested by Mueller. Accordingly, the present claims are nonobvious over Mueller.

- b) Claims 9-17 and 19-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennel (U.S. Patent No. 6,135,654) in view of Merriman et al. (U.S. Patent No. 5,948,061).

The Examiner asserts that Jennel discloses a method and apparatus for printing digital graphic images directly on a bottle and Merriman discloses methods and apparatuses for targeting the delivery of advertisements over a network such as the internet.

Claims 19-20 have been canceled and Claims 9-17 have been amended to depend from Claim 1. Claims 9-17 are therefore patentable by reciting of their depending on claim 1.

Moreover, the combination of Jennel with Merriman would not create the presently claimed invention. The Examiner admits that the Jennel reference does not teach any method to ensure that the consumer does not see the same image repeated. The Examiner relies on Merriman to supply this and other elements of the claim. As described above, the presently pending claims recite that the images in the group of packages are "randomly selected". In contrast, Merriman does not randomly select images. Rather, Merriman relies on receiving information from the user to determine "if the number of times that the user has seen the advertisement is less than a predetermined threshold" (page 6, column 2, lines 20-21). Such information cannot be obtained in the concept of the present invention because the consumer purchasing the packages has no direct contact with the packager. Accordingly, the present invention relies on random selection to ensure that the packages appear to the consumer to bear different images. Nothing in either Merriman or Jennel would suggest the random selection recited in the presently pending claims. Accordingly, withdrawal of rejection under 35 U.S.C. § 103(a) is respectfully requested. DEA
5/25/05

CONCLUSION

In light of the Applicant's amendments to the claims and foregoing Remarks, it is respectfully submitted that the present application. Should the Examiner have any remaining concerns, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 25 May 2005

By: Daniel E. Altman
Daniel E. Altman
Registration No. 34,115
Attorney of Record
Customer No. 20,995
(949) 760-0404